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INDEFINITENESS

Claims 1-11 were rejected because the term "nonadhesive...nonwoven," added by the amendment of December 24, 2002, in conjunction with the limitation "an adhesive coating" is alleged by Examiner to be indefinite and confusing. Specifically, Examiner raises the following issues in support of the rejection:

1. It is not clear to the Examiner "just how a prospective infringer would be expected to determine whether or not the presence of adhesive might be considered part of the non-woven backing, or whether instead it would be considered part of the adhesive coating." See Office Action, page 2, ¶2.
2. Further, it is alleged that Applicants "give no such guidelines," to make the necessary determination. Therefore the Examiner apparently believes the public is not being given sufficiently clear notice of the claimed subject matter.

PTO Guidelines on Indefiniteness

"The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available." MPEP § 2173.02. (Emphasis added).

In addition, "the Examiner should allow claims which define patentable subject matter with a reasonable degree of particularity and distinctness." MPEP § 2173.02 (Emphasis in original). Thus, PTO's guidelines direct examiners to interpret claim language with "some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire." *Id.*

Further, the definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;

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(B) The teachings of the prior art; and

(C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

See MPEP § 2173.02.

Interpreting Claim 1

It is respectfully suggested that if claim 1 were analyzed by the rules set forth in the MPEP, it would not be found indefinite and confusing. Claim 1 is reproduced below.

1. (Amended) A combination comprising a nonadhesive metallocene-polyethylene nonwoven as backing material and a self-adhesive coating, said backing material being provided on at least one side with said self-adhesive coating.

The claim recites a nonadhesive...nonwoven backing material and a self-adhesive coating, wherein said backing is provided on at least one side with said self-adhesive coating. The claimed combination as recited above, describes two components, a nonwoven and an adhesive.

The second clause specifies the arrangement of these same two components – i.e., said backing is coated with said adhesive coating.

In order for the indefiniteness rejection set forth above to be reasonable, persons of ordinary skill in the art would have to reasonably interpret claim 1 as describing a non-adhesive nonwoven that (i) is inherently adhesive in the absence of an adhesive coating, or (ii) has an adhesive component integrally co-mingled with the nonwoven fibers during manufacture. These are the only interpretations of claim 1 that could cause a prospective infringer to read claim 1 and question whether the adhesive component might be part of the non-woven backing as opposed to a separate layer of adhesive coating.

Respectfully, it is believed in good faith that these alternative interpretations are not reasonable given the knowledge in the art, as well as the disclosure. Specifically, there is

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not any disclosure in the specification that expressly or impliedly supports such an interpretation, and Examiner has not yet directed our attention to such.

Claim language is to be interpreted by giving terms their plain meaning in the art, unless the Applicants modify such meaning in the specification. MPEP § 2173.05(a). However, "while a term used in the claims may be given a special meaning in the description of the invention, generally *no term may be given a meaning repugnant to the usual meaning of the term.*" MPEP § 2173.05(a) (citing, *In re Hill*, 73 USPQ 482 (CCPA 1947)) (Emphasis added).

In this context, it is noted that in supporting the rejection, Examiner apparently ignores the plain meaning of the term *nonadhesive*, and instead interprets it as possibly meaning that the nonwoven actually has adhesive properties of its own. Ironically, in setting out the new matter rejection, Examiner expressly asserts that "nonadhesive" is the equivalent of "free of adhesive." In view of Examiner's interpretation, the indefiniteness rejection seems improperly based on very unlikely alternative interpretations of claim 1.

Consistent with the conclusion that these interpretations are unlikely, is the fact that no nonwoven backing material, or fibers thereof, having inherent adhesive properties is either explicitly or impliedly described anywhere in the application.

In addition, the sections in the specification disclosing the preparation and testing of the nonwoven and the claimed combination are explicitly separated into two portions: (i) pages 5-7 describe the uncoated nonwoven's properties, and (ii) the last line of page 7 onto page 8 describe the properties of the claimed combination; i.e., the nonwoven after coating with adhesive. The fact that all adhesive properties are tested only after the adhesive coating is applied is clear evidence that the non-coated nonwoven lacked significant adhesive properties.

Thus, given the specification's teachings and the plain meaning of the term "nonadhesive," it is respectfully suggested that the hypothetical confusion that Examiner suggests will be experienced by a prospective infringer would almost certainly not occur.

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The indefiniteness rejection under § 112, 2nd, may be properly withdrawn and such withdrawal is respectfully requested.

NEW MATTER

Claims 1-11 were rejected for allegedly introducing new matter. Specifically, Examiner believes that the term "nonadhesive nonwoven as backing material" is unsupported in the specification. In support of this conclusion, Examiner asserts that the negative limitation is the equivalent of "free of adhesive" and, therefore violates the rule of *Grasselli*.

Further, Examiner interprets the holding in *Grasselli* as meaning, "that limitations such as "free of" a certain ingredient or element is new matter in the absence of express disclosure giving support to the limitation." Office action, mid-page 4. In essence, Examiner sees *Grasselli* as providing a *per se* bar against negative claim limitations. This interpretation of *Grasselli* and its application to the instant rejected claims, is in direct contradiction with current PTO practice.

Also relevant is that Examiner believes that Applicants' reliance on *In re Anderson* to support the propriety of the amendment in question is essentially irrelevant, because *Anderson* "has *nothing whatsoever* to do with whether proper support for negative limitations can be found in the absence of express disclosure." This conclusion is also inaccurate.

Current PTO Standard in Determining a New Matter Rejection

The exceedingly narrow and purposeful interpretation that Examiner attributes to the opinion in *Grasselli* is not supported by the text of the published opinion. In fact, such a view of negative limitations directly contradicts PTO policy.

"The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection

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sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph." MPEP § 2173.05(I), entitled Negative Limitations.

It was later stated in *Ex parte Parks*, that "[a]ny claim containing a negative limitation which does not have a basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a prima facie case for lack of descriptive support." *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993).

Thus, Examiner's assertion that a negative limitation, or any limitation for that matter, must have express disclosure for support, is clearly incorrect.

In harmonizing *Parks* with *Grasselli*, the BPAI stated:

Under the particular facts in that case (i.e., *Grasselli*) it was held that the negative limitation *introduced new concepts* in violation of the description requirement of the first paragraph of 35 U.S.C. 112, *citing In re Andersen*."

See *Parks*, at page 1236 (Emphases and parentheses added). Thus, in *Parks* as in *Grasselli*, the case *In re Anderson* set the conceptual legal framework for the courts' opinions. Thus, Anderson's rule is critical to assessing the present rejection.

Both the Board of Patent Appeals and the MPEP state that *Grasselli* does not set out a rigid *per se* rule that negative limitations render a claim nonallowable, or that negative limitations require express support in the disclosure in order to be proper. The MPEP states that in being their own lexicographer, an applicant "may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the claimed subject matter..." MPEP § 2173.01 (citing *In re Swinehart*, 160 USPQ 226 (CCPA 1971)) (Emphasis added).

The Negative Limitation in Claim 1 is not Similar to that in *Grasselli*

In affirming the rejection of the negative limitation for introducing new matter, the *Grasselli* court was confronted with a limitation describing a catalyst as *free of uranium and*

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the combination of vanadium/phosphorous. The court affirmed that the catalyst was not adequately described.

This is because by trying to describe the catalyst as not having a mere few elements, i.e., uranium and the combination of vanadium/phosphorous, also meant that virtually anything else was encompassed by the catalysts. The court affirmed the rejection in this case because the negative limitations broadened the scope of the catalyst to encompass a virtually infinite number of element combinations, which of course, were not described.

Thus, the court found that the limitation introduced "*new concepts and violated the written description requirement of the first paragraph of 35 USC § 112. In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973)." See *Graselli*, 231 USPQ at 394.

In the present case, the term "nonadhesive nonwoven" does not introduce any new concepts because the term nonadhesive nonwoven is completely consistent with the specification. There is no disclosure indicating that the nonwoven backing possessed any adhesive properties except those imparted by the adhesive coating. Thus, a nonwoven nonadhesive was not a newly introduced concept.

Further, claim 1's "negative" limitation expressly discloses that only nonadhesive nonwoven backings are encompassed, which is precisely what the combination comprises. Thus, in the present case, the negative limitation narrows the claim's scope, and affirmatively describes what the backing is. *This is completely the opposite effect of the negative limitation in Graselli.*

Put another way, the negative limitation in claim 1 clearly narrows subject matter to encompass embodiments that are clearly disclosed. In contrast, *Graselli* broadened the claims tremendously to encompass catalysts having almost any composition and were not disclosed in *Graselli's* specification.

In sum, the addition of the term "nonadhesive nonwoven" did not result in a descriptive gap as did the negative limitations in *Graselli*; i.e., the present amendment does not present the subject matter in a conceptually distinct or new form.

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Accordingly, it is respectfully requested that the rejection be withdrawn because the facts of the instant application do not reasonably resemble those of *Grasselli*. In fact, the claim limitations have directly opposite effects on the scope of the claims, so that in the instant applications, the claims are still encompassed by the original disclosure.

NEW CLAIM 12

It is no doubt quite clear that Applicants believe that amended claim 1 is neither indefinite nor does it contain conceptually new matter.

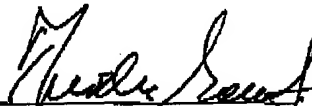
However, in the hope of expediting allowance of the application, it is proposed that, should Examiner feel unable to withdraw the rejections, that he provisionally consider new claim 12 as a substitute for the main claim rather than claim 1. Claim 12 describes the combination without the use of a negative limitation. Therefore, if agreeable to Examiner, claim 12 may replace claim 1, and the latter may be canceled.

Applicants believe that the rejections have been overcome by the ensuing remarks alone, or in combination with the amendment adding new claim 12.

Allowance of the claims is earnestly solicited.

Respectfully Submitted,

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MARK-UP OF AMENDED VERSIONS

I. A combination comprising a ~~non~~adhesive-metallocene-polyethylene nonwoven as backing material, said backing material having applied to at least one of its sides of a coating of and a self-adhesive coating. ~~said backing material being provided on at least one side with said self-adhesive coating; and wherein the adhesive properties of said combination are imparted thereto, by said self-adhesive coating.~~